UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,878	08/24/2001	Nila Patil	HO-P02199US2	2515

31662	7590	02/18/2004

PERLEGEN SCIENCES, INC.
LEGAL DEPARTMENT
2021 STIERLIN COURT
MOUNTAIN VIEW, CA 94043

EXAMINER
FREDMAN, JEFFREY NORMAN

ART UNIT	PAPER NUMBER
1634	

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Advisory Action	09/938,878	PATIL ET AL.
	Examin r	Art Unit	
	Jeffrey Fredman	1634	

--The MAILING DATE of this communication appears on th cover sh et with the correspondence address --

THE REPLY FILED 05 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
      NOTE: _____.

3.☐ Applicant's reply has overcome the following rejection(s): _____.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

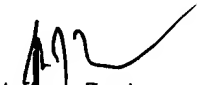   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *24-40*.

   Claim(s) withdrawn from consideration: _____.

8.☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9.☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10.☐ Other: _____

Jeffrey Fredman
Primary Examiner
Art Unit: 1634

Continuation of 5. does NOT place the application in condition for allowance because: Applicant first argues that a gridded plate is not the same as a nucleic acid probe array. This argument fails to look at the Zonana reference as a whole. Zonana does not simply refer to the gridded plate. Zonana also ref rs to how th gridded plate will be analyzed. Zonana teaches, as noted in the final rejection, the express use of DNA chips at column 54, lines 5-9. So that when, in column 23, Zonana teaches that "Bacteria were grown on gridded plates prior to further analysis", one form of obvious analysis is that expressly taught by Zonana, which is hybridization to DNA chips. Zonana also teaches hybridization assays in columns 24 and 26, which include the common motif of binding nucleic acids such as those on the gridded plates to arrays and hybridizing probes to those arrays. Finally, It is the combination which renders the claim obvious, and given Zonana's desire to use such arrays for analysis, and Dong's teaching that the arrays are so used, the claimed invention is prima facie obvious.

Applicant then argues that the method could not be combined because the sequence of the DNAs was not yet known. However, that is not correct. It is clear from Dong that the array need not be specifically manufactured with a priori knowledge of the sequence of int rest for the analysis. As Dong expressly notes "The isolated sequences are then exposed to an array which may or MAY NOT have been specifically designed and manufactured to interrogate the isolated sequences (emphasis added, see Dong, column 5, lines 58-60)". Thus, Applicant's central point is rebutted by Dong, who shows that the sequence need not be known to obtain useful information. So when Applicant argues that the method would be useless, this is not correct, since by combining with Dong, an ordinary practitioner would obtain isolated sequences that were interrogated with particular probes that would give information regarding the content of the sequences. Dong exemplifies one such use, which is SNP discovery using arrays with unknown starting sequences (see example 5). This is perfectly compatible with Zonana, who is interested in SNPs as shown by the allele specific detection of SNPs (see column 19, for example). So the methods are combinable for the purpose of characterizing SNPs, for example, among many other uses contemplated by both Zonana and Dong.

Applicant relies upon overcoming the primary rejection to overcome the further rejection over Wigler. Since the primary rejection is maintained for the reasons given, so is the rejection with Wigler. .

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